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COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061			ZURITA, JAMES H	
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			3625	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/518,916	LUKAS ET AL.	
	Examiner	Art Unit	
	James H Zurita	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 March 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-39 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 March 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 17 March 2005 has been entered.

Response to Amendment

On 17 March 2005, applicant amended claims 1, 18, 37 and added claims 38-39.

Claims 1-39 are pending and will be examined.

At the onset, the Examiner notes that claims 1, 18 and 37 refer to formatted displays that are based on updated user profiles. The Examiner finds these recitations sufficient to overcome concerns that may be raised under 35 USC 101, since the specifications clearly disclose that such displays are formatted via computer executable instructions using data stored in various electronic databases. The formatted displays are presented to users, who interact with computers to select options on a terminal; these selections in turn affect the data that is stored.

Claim Rejections - 35 USC § 112 – First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13 reads,

The method of Claim 1, wherein, when said user does not respond to said formatted display within a period of time, said response comprises a signal that said user has chosen not to respond to said formatted display.

Applicant does not explain how there can be a response when a user does not respond [...within a certain period of time...]. That is, applicant does not explain how a *non-existing* response can comprise **anything**, including a signal, as claimed.

Claim 31 refers to *user selectable event tag*, not otherwise mentioned in the specifications. The term will be interpreted to mean computer instructions that are executed when a customer makes a selection on a screen.

Claim Rejections - 35 USC § 112 – Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 13 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 reads,

The method of Claim 9, wherein said correlation between said component in said product and said characteristic in said user profile is reduced when there is a conflict between a first and a second component in a plurality of components associated with said base product.

Applicant's disclosures read:

The configuration is not considered completed when there is a conflict between one or more pairs of options selected. An exemplary conflict is a situation in which the user has picked, for example, a high quality computer monitor and a graphics card that does not support such a monitor. Sales module 104 further provides tools such as "update the current price" 1112 and "add to cart" 1114. page 38, lines 13-18.

The term ***correlation between [...] product component and [...]*** ***characteristic in a user profile***, appear to refer to a relative desirability or relative importance attached to a particular component by a customer based on data stored as part of consumer information, and as expressed via customer's selections on a screen. However, the claims do not provide a way to measure this ***relative*** affiliation.

Claim 13 reads,

The method of Claim 1, wherein, when said user does not respond to said formatted display within a period of time, said response comprises a signal that said user has chosen not to respond to said formatted display.

It is not clear, how there can be a [said] response when a user does not respond [...within a certain period of time...]. That is, applicant does not explain how a *non-existing* response can comprise ***anything***, including a signal, as claimed. Claim 13 will be interpreted to read on a ***time out*** arising from the

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absence of a response from a user after a period of time, as is common in login and password entry, for example.

Claim 32 reads,

The computer readable memory of Claim 28, wherein said sales module further comprises **instructions** for terminating an instance of said advisor module when a second election is received by **said instructions** for receiving an election; said second election including an indication that said user wishes to terminate said instance of said advisor module.

It is not clear what is the antecedent basis for ...**said instructions**... since there are 15 sets of possible instructions that can serve as antecedent (claim 32 also refers to another set of instructions, claim 28 refers to 6 sets of instructions and claim 18 refers to an additional 8 sets of instructions). The claim will be interpreted to refer to any type of machine instruction. Prior Art will be found to read on claim 32 where prior art discloses the use of multiple buttons on a screen, since the multiple buttons permit users to select and unselect various choices, including requests for assistance.

Claim Objections

Claims 1, 7 and 30 are objected to because of the following informalities:

Claim 1 contains word processing errors and should be corrected to read:

- (a) obtaining...;
- (b) providing...;
- (c) updating...;
- (d) storing...;
- (e) repeating steps (b) through (d) at least once to optimize said product.

Claim 7 refers to "...said component in said **user profile**..." Other claims refer to characteristics in said user profile and use the term component to refer to base product. This appears to be a word processing error.

Claim 30 refers to a ***sales module database*** that stores pricing information associated with a product. This appears to be an error, since later references are to a ***sales database***.

Appropriate correction is required.

Rejections under 35 U.S.C. 102 and 103

First alternate Rejection

Claims 1-12, 14-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (US Patent 6,167,383).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Official Notice.

Second Alternate Rejection

Claims 1-12, 14-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (US Patent 6,167,383).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Official Notice.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Dell Uses Internet to Offer Small Business Customers Personalized Sales and Educational Programs, *Business Editors & Technology Writers*. *Business Wire*, New York: Jul 20, 1998, downloaded from ProQuest on the Internet on 14 October 2004, 2 pages.

The following comments apply to all rejections.

Where applicant provides no explicit definition for a term, the Examiner relies on the term's ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003): This applies to the following terms:

A **database** is any aggregation of data; a database is a file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.¹ The claims are drawn to various named databases, including Sales database, claim 30, User profile database, claims 18, 26, 33, Knowledge database, claim 27, Advisor interaction database, claim 33, product preference database, claim 33, Product selection database, claim 33. The Examiner notes that the various labels do not provide patentable distinction. For purposes of this examination, the term database will be given its broadest reasonable interpretation to include logical and physical aspects of databases, including tables, files, views, etc. Prior art will be interpreted to read on the claims where prior art discloses storage and use of data related to particular functions.

Modules and instructions. The claims are drawn to various named modules and instructions, including Advisor module, claims 18, 28, 29, 31, 32, 35, 36 and Sales module, claims 28, 29, 30, 31, 32. The Examiner again notes that the various labels do not provide patentable distinction. For purposes of this examination, the terms modules and instructions will be given their broadest reasonable interpretation to include

¹ Definition of Database, MICROSOFT PRESS Computer Dictionary.

computer instructions that perform various functions. Prior Art will be interpreted to read on the claims where prior art discloses the various functions.

automated assistance will be given its broadest reasonable interpretation to include selecting a help button, such as shown in Fig. 3C, as well as a customer's interaction over a telephone with help/support/sales personnel. Please note that the term "automated assistance" does not appear in applicant's disclosures; applicant refers to "...general assistance..."

user profile is a computer-based record maintained about an authorized user of a multiuser computer system.² Consistent with this definition, **user profile** will be given its broadest reasonable interpretation to mean storage and use of customer information including, but not limited to, user addresses, email information, telephone number, shopping history, shopping cart activity, etc.

event (as in User generated event, claim 11; User event, claim 16, 17; Event record, claim 29; User selectable event, claim 31) will be given its broadest reasonable interpretation to mean computer instructions that are executed in response to action(s) taken by a consumer when interacting with a computer, via a web page. For example, the term **user selectable event tag**, not otherwise mentioned in the specifications, will be interpreted to mean computer instructions that are executed when a customer makes a selection on a screen. Henson discloses the use of selectable events to notify the system that a user has made a selection, or when a user requests assistance, such as

² Definition of *user profile*, MICROSOFT PRESS Computer Dictionary.

when a user presses a help button (Applicant's new claim 37, automated assistance at the request of a user). For example, Col. 13, lines 6-53.

correlation between a product component and a characteristic in a user profile, (claims 9-12 and 24) will be given its broadest reasonable interpretation to mean the desirability or relative importance attached to a particular component by a customer based on data stored as part of consumer information, and as expressed via customer's selections on a screen.

First alternate Rejection - Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-12, 14-37 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (US Patent 6,167,383).

As per claim 1 Henson discloses methods for optimizing a product, the product including a base product (a computer), the method comprising steps;

a **obtaining** an identification of a user. See, for example, references to Premier Pages and access by customers, including password. This information is part of a user profile. See at least Col. 14, lines 14, lines 19-61. Henson also discloses obtaining a preliminary designation of a product (a computer, for example).

Henson discloses identifying a user profile that is uniquely associated with the user, the user profile including at least one characteristic corresponding to the specific, individual user. Characteristics may include a user's billing address, shipping address, home address for home consumers, as in Col. 11, lines 63-Col. 12, line 9, password (password protected access), for example. It may also include a classification as to the specific type of user, including identification as an individual customer. See at least Col. 14, lines 14, lines 19-61.

b. **providing a formatted display** that includes a set of content related to the product and a format, the set of content and the format determined by the at least one characteristic in the user profile; See, for example, references to displaying information that is relevant to a given customer, as in Col. 13, lines 53-61. See also at least references to consumer-specific variations of online stores and checkout, as in Col. 11, lines 10-31. See also references to displaying configurator views according to user preferences, as in Col. 9, lines 8-24 and Fig. 5, for example.

c **updating**, based on a response by the user:

c.1 the at least one characteristic in the user profile to create an updated user profile. See, for example, at least references to a user shipping information. This information is also part of the specific user's profile and is saved to create updated user information of a profile.

c.2 a component associated with the base product when the response includes a selection of an option from a different set of options associated with the component. See, for example, references to cart content screening, as in Col. 10, lines 18-67.

d) **storing** the **updated** user profile to determine the set of content and format of the formatted display for a future representation made to the user. See, for example, at least references to saving a cart (portion of a user profile) and viewing the cart later, as in Fig. 6, least Col. 9, lines 26-67.

e) repeating steps (b) through (d) at least once to optimize the product. See, for example, at least Fig. 6, which shows that carts may be saved **for ordering later**. Formatted displays are provided when a user selects a different option of a component such as Memory, for example, as in Fig. 5. Henson's steps may be repeated until a user is satisfied with a product, i.e., until a user has optimized a product.

As per claim 2, Henson discloses that a product may further include a plurality of components associated with a base product, each component in the plurality of components corresponding to, and selected by the user from, a different set of options, using the formatted display. See, for example, at least Fig. 5 and related text.

As per claim 3, Henson discloses a default option is designated for each component in the plurality of components. See, for example, Fig. 4 and related text.

As per claim 4, Henson discloses that a formatted display comprises a menu including one or more elements selected from the group consisting of an option selected from the different set of options associated with the component, a frequently asked question associated with the component, an instructional sequence prompt, and a recommendation message. See, for example, at least Fig. 4, which shows a menu that includes an option from a different set of options associated with a hard drive, a component of a base product.

As per claim 5, Henson that a characteristic in the user profile that is updated in step (c) of Claim 1, based on the response to the formatted display may determine an element that is included in the menu in a subsequently executed instance of step (b) of Claim 1. See, for example, Fig. 6, which discloses saving a cart for later ordering. When the cart is displayed later, the cart contains elements (previously selected from menus).

As per claim 6, Henson discloses that a formatted display provides a portion of a set of options corresponding to a component associated with the base product. See, for example, at least Fig. 5, a formatted display that provides a portion of a set of options for hard drives, a component associated with a computer base product.

As per claim 7, Henson discloses that a response to the formatted display of step (b) includes a designation of an option for a component associated with the base product and step (c) further comprises the step of updating the component in the user

profile. See, for example, Fig. 5 and 6, which shows that user selection, such as a processor type, are saved and stored in a shopping cart, which stores updated information as part of a user profile.

As per claim 8, Henson discloses that a product is optimized when the user indicates that the product is optimized. See, for example, at least Fig. 6, which discloses that a user may place an order. The user indicates that a product is optimized for the user when the user places an order for the product.

As per claim 9, Henson discloses that a formatted display reports a correlation between a component in the product and a characteristic in the user profile when the correlation exceeds a threshold value. See, for example, references to the importance of lead times to various types of users, and that lead time indicators appear according to type of user, at least Col. 14, lines 35-61.

As per claim 10, Henson discloses that correlation between a component in a product and a characteristic in a user profile may be reduced when there is a conflict between a first and a second component in a plurality of components associated with the base product. See, for example, at least references warnings concerning compatibility issues among selected system component options, as in Col. 2, lines 5-48.

As per claim 11, Henson discloses that determining a change to a component in the plurality of components associated with a base product may maximize the correlation between the component in the product and the characteristic in the user profile. See, for example, references to messaging for recommending options that may be better than others according to different configurations, as in Col. 6, lines 21-43. The

recommendation may be presented in response to a user generated event (for example, a help button); and implementing the change to the product when a confirming response is received. See also references to compatibility warnings and consumer response, as in Col .15, lines 45-60.

As per claim 12, Henson discloses that a product may further include a plurality of components associated with the base product, each component in the plurality of components associated with, and selected from, a different set of options. See Figs. 4-5 and related text, for example.

Henson also discloses that the correlation between a component associated with the product and a characteristic in the user profile exceeds a threshold value when the response to the formatted display of step (c) includes a designation of an option for a component associated with the base product. Fig. 4-5, for example, show that customers may select components according to the relative perceived importance in a customer's selection.

As per claim 14, Henson discloses options for a component are presented in the formatted display of step (b). See, for example, at least Fig. 5, which shows a formatted display with options for several components of a base product. Each component may be selected dynamically from a plurality of components associated with a base computer product. A base product (computer, for example) may be based on a characteristic of a user profile, such as type of user. See, for example, at least references to different types of computers and components according to type of user, such as an individual or corporation, as in Col. 14, lines 4-34.

As per claim 15, Henson discloses the steps of transmitting a set of questions, receiving at least one answer to the set of questions; and updating the characteristic in the user profile based on the at least one answer. See, for example, references to stores allowing customers to answer questions, as in Col. 1, lines 28-46. see also references to questions that are asked or not asked according to different user profiles, as in Col. 13, lines 6-28. Please note that customers may be classified as personal, business, institutional users according to information provided by customers in response to questions. Formatted displays are customized accordingly.

As per claim 16, *Henson* discloses a characteristic in the *user profile* associated with the user is modified based on a user event associated with the user occurring during an optimization of a different product. See, for example, Fig. 5 and related text, which shows that a user may select a non-default option for a component. Such selection is an event that triggers an update of a shopping cart, which stores the selected (or newly selected) component. As noted above, a shopping cart is information that is stored about a user.

As per claim 17, Henson discloses a characteristic in the user profile associated with the user is modified based on a user event associated with the user occurring during an optimization of the product during a different session. See, for example, references to saving a cart, as in Fig. 6. The information contained in the cart may be modified with actions taken by a customer that occur during optimization of a computer during a later session, for example.

As per claim 18, Henson discloses memory to direct a computer to optimize a product, the product including a base product (a computer, for example) comprising:

a user profile database stored in the memory. See, for example, at least references to database 24. Henson discloses that each profile in the user profile database is uniquely associated with a different user and including a characteristic that corresponds to the user. See, for example, references to Premier Pages and access by customers, including password. This information is part of a user profile. See at least Col. 14, lines 14, lines 19-61.

executable instructions, including:

a) **instructions for obtaining an identification** of the user and a preliminary designation of the product; the identification identifying a user profile associated with the user that includes at least one characteristic corresponding to the user in the user profile database. The instructions permit Henson to identify a user profile that is uniquely associated with the user, the user profile including at least one characteristic corresponding to the specific, individual user. Characteristics may include a user's billing address, shipping address, home address for home consumers, as in Col. 11, lines 63-Col. 12, lin3 9, password (password protected access), for example. It may also include a classification as to the specific type of user, including identification as an individual customer. See at least Col. 14, lines 14, lines 19-61.

instructions for creating a user profile when a user profile does not exist

See, for example, at least Col. 12, lines 19-40, which disclose creating of **new** customers and customer sets when they do not exist.

b) ***instructions for providing a formatted display*** that includes a set of content related to the product, the set of content and the format determined by a function of a the at least one characteristic in the user profile. See, for example, references to displaying information that is relevant to a given customer, as in Col. 13, lines 53-61. See also at least references to consumer-specific variations of online stores and checkout, as in Col. 11, lines 10-31. See also references to displaying configurator views according to user preferences, as in Col. 9, lines 8-24 and Fig. 5, for example.

c) ***instructions for updating***, based on a response by the user (e.g., Fig. Fig. 6, SAVE MY CART):

c.1 the at least one characteristic in the user profile to create an updated user profile. See, for example, at least references to a user shipping information. This information is also part of the specific user's profile and is saved to create updated user information of a profile.

c.2 a component associated with the base product when the response includes a selection of an option from a different set of options associated with the component. See, for example references to cart content screening, as in Col. 10, lines 18-67.

d) ***instructions for storing*** the ***updated*** user profile to determine the set of content and format of the formatted display for a future representation made to the user. See, for example, at least references to saving a cart (portion of a user profile) and viewing the cart later, as in Fig. 6, least Col. 9, lines 26-67.

e) ***instructions for repeating*** steps (b) through (d) at least once to optimize the product. See, for example, at least Fig. 6, which shows that carts may be saved for ordering later. Formatted displays are provided when a user selects a different option of a component such as Memory, for example, as in Fig. 5.

Claim 19 is rejected on the same grounds as claim 2.

Claim 20 is rejected on the same grounds as claim 3.

Claim 21 is rejected on the same grounds as claim 6.

Claim 22 is rejected on the same grounds as claim 7.

Claim 23 is rejected on the same grounds as claim 8.

Claim 24 is rejected on the same grounds as claim 9.

Claim 25 is rejected on similar grounds as claim 13.

As per claim 26, Henson discloses instructions for querying the aggregation of customer data and identifying the user profile from a response to the query. See, for example, references to retrieving stored customer information, as in saving and retrieving a cart, Fig. 6.

Where a response to the query fails to identify the profile, Henson discloses instructions for initiating a new user profile and associating the new user profile with the user. Henson also discloses that this new profile information is saved, such as for generating a customizable checkout for a particular customer according to the customer's needs. See, for example, at least Col. 12, lines 19-40, which disclose creating of new customers and customer sets.

As per claim 27, Henson discloses storing data, where the aggregation of data includes description of a base product and a description of at least one option in at least one set of options corresponding to a component associated with the base product. See, for example, at least references to products and product information that is displayed for individual customers, as shown by Figs. 4-5, for example. The displayed formats of Figs. 4-5 are displayed by the execution of instructions that provide formatted displays. They include instructions to display sets of options corresponding to a component selected from the plurality of components (for example, in Fig. 5, see at least pull down menus for accessing description(s) of an option (such as memory) in the different set of options (memory, hard drive, monitor, etc.) associated with the component, drawn from product data. The function may also comprise a comparison of the description with the characteristic in the user profile. For example, the user profile may indicate a need for a computer with memory. The displayed information contains component information concerning memory; the description of various types of memory may include information such as SDRAM with ECC, as shown in Fig. 5.

As per claim 28, Henson discloses

- providing a product selection choice (via instructions that provide product selection choice); each the product in the product selection choice including a base product and at least one default component. See, for example, Figs. 4-5, i.e., formatted displays that show the results of instructions that provide product selection choice).

- receiving an election (via instructions for receiving an election); the election designating a product in the product selection choice. The instructions execute as a customer selects an option in a product selection formatted display of Figs. 4-5.
- determining (via instructions for determining) when to call an instance of the instructions for handling requests for assistance. See, for example, HELP ME CHOOSE buttons, Fig. 5. When a customer selects the button, Henson calls an instance of instructions for handling requests for assistance.
- calling an instance (via instructions for calling an instance) of the instructions for handling requests for assistance. See, for example, HELP ME CHOOSE buttons, Fig. 5. When a customer selects the button, Henson calls an instance of the instructions for handling the request for assistance.

As per claim 29, Henson discloses instructions for generating an event record (e.g., determining that a customer has pressed a help button) when a customer requests assistance by pressing a help button, the customer is presented with customized assistance and information. See, for example, at least Figs. 4-5.

As per claim 30, Henson discloses

- storing pricing information associated with the product. See, for example, at least references to pricing, at least Col. 2, line 50-Col. 3, line 3, line 12.
- querying the aggregation of data for pricing information corresponding to the product selection. See, for example, at least Fig. 5, and references to configured price.
- transmitting the pricing information. See, for example, at least Fig. 5, which shows that the pricing information has been transmitted to a customer via a browser.

As per claim 31, Henson discloses

- instructions for providing a user selectable event. See, for example, Figs. 4-5, which show that a customer may select various options. When a customer selects an option, the system generates an event for the selection. See also displays of HELP ME CHOOSE buttons.
- "instructions for receiving an indication that said user selectable event tag has been selected by said user; said sales module further including instructions for notifying said instructions for handling requests for assistance when said tag is received".* In other words, instructions for providing assistance when a customer selects a help button, as shown in Figs. 4 and 5, for example.

As per claim 32 (interpreted in light of rejection under 35 U.S.C. 112) Henson discloses that a user may select (initiate) and unselect (terminate) options on a formatted display, including requests for assistance. See, for example, Fig. 4.

As per claim 33, Henson discloses that a user profile may include a user identifier (a user name, or userid, or password, for example, as in PREMIER PAGES password, Col. 14, lines 35-61) and at least one entry selected from the group consisting of

- a domain familiarity indicator,
- an advisor interaction database,
- a product preference database,
- a product selection database, and
- a user characteristic.

See, for example, at least references to storing information concerning customer characteristics for checkout and presenting information concerning business lease information for at-home buyers, as in Col. 12, line 11, line 64-Col. 12, line 39.

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Claim 34 is rejected on the same grounds as claim 4.

As per claim 35, Henson discloses a manifestation of the instructions for handling requests for assistance includes at least one feature selected from the group consisting of an on-screen character, an audible voice, text, a multimedia prop, and a sound effect. See, for example, at least Figs.3-4 and green check marks, at least Col. 8, lines 7-34. For text, see at least references to merchandising messages, as in Col. 13, lines 53-Col. 14, line 18. A character is a letter, number, punctuation mark or other symbol or control code that is represented to a computer by one unit [1 byte] of information.³ For an on-screen character, please see question marks found in HELP ME CHOOSE, Figs. 4-5, for example. See also character(s) displayed in Figs. 3A-10.

As per claim 36, Henson discloses

- instructions for storing a record of the product optimization. See, for example, at least Fig. 6, SAVE MY CART button
- instructions for resuming a product optimization based on a stored record of a prior product optimization. See, for example, at least Fig. 6, CONTINUE SHOPPING button, which shows that retrieval of previously stored information of prior product optimization for resuming product optimization. See also references to shopping cart, which is information that is stored for later retrieval and continued activity such as shopping and product optimization.

³ Definition of *character*, MICROSOFT PRESS Computer Dictionary.

As per claim 37, Henson discloses methods for optimizing a product, the product including a base product (a computer), the method comprising steps of:

- a obtaining an identification of a user and a preliminary designation of the product; the identification identifying a user profile that is uniquely associated with the user, the user profile including at least one characteristic corresponding to the user. See rejection of claim 1(a).
- b providing a formatted display that includes a set of content related to the product and a format, the set of content and the format determined by the at least one a characteristic in the user profile. See rejection of claim 1(b).
- c updating, based on a response by the user:
 - c.1 the at least one characteristic in the user profile to create an updated user profile. See rejection of claim 1(c.1).
 - c.2 a component associated with the base product when the response includes a selection of an option from a different set of options associated with the component. See rejection of claim 1(c.2).
- d storing the updated user profile to determine the set of content and format of the formatted display for a future representation made to the user. See rejection of claim 1(d).
- e repeating steps (b) and (c) at least once to optimize the product. See rejection of claim 1(e).
- f providing automated assistance at the request of the user. See, for example, Fig. 3A, buttons "HELP ME CHOOSE".

As per claim 38, Henson discloses PREMIER PAGES, Col. 14, lines 35-61. PREMIER PAGES keep track of a customer's purchase and service history, as evidenced by Dell Uses Internet to Offer Small Business Customers Personalized Sales and Educational Programs, Business Editors & Technology Writers. Business Wire, New York: Jul 20, 1998, downloaded from ProQuest on the Internet on 14 October 2004, 2 pages. Please note that Dell is cited merely to explain the meaning of the term PREMIER PAGES, and to show that characteristics not disclosed in Henson are inherent in PREMIER PAGES. See MPEP 2131.01, Multiple Reference 35 U.S.C 102 rejections.

As per claim 39. Henson discloses that at least one characteristic in a user profile comprises an indication of the user's price sensitivity. See, for example, at least references to price sensitivity such as discount pricing, which may be applicable to different customers; such information is stored in a user profile. Col. 14, lines 35-61.

First Alternate Rejection - Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Official Notice.

Claim 13 is interpreted in light of the rejection under 35 U.S.C. 112.

As per claim 13, Henson **does not** specifically disclose that if a user does not respond to a formatted display within a period of time, the system may generate an

event that the user has chosen not to respond to the formatted display within the period of time, as in a time out.⁴ Henson discloses the use of passwords and logins, as in Col. 11, lines 63-Col. 12, line 9. Official Notice is taken that it was old and well known at the time of applicant's invention to include time outs in the absence of user response to a formatted display. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and general knowledge to disclose that if a user does not respond to a formatted display within a period of time, the system may generate an event that the user has chosen not to respond to the formatted display within the period of time. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Henson and general knowledge to disclose that if a user does not respond to a formatted display within a period of time, the system may generate an event that the user has chosen not to respond to the formatted display within the period of time for the obvious reason that by doing so, a system may thus protect itself against crackers.

Second Alternate Rejection - Claim Rejections - 35 USC § 102

Claims 1-12, 14-37 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (US Patent 6,167,383). See above.

⁴ A timeout is an event that indicates that a predetermined amount of time has elapsed without some other expected event taking place; a time-out event is used to interrupt the process that had been waiting for the other expected event. For example, a system might allow a user 60 seconds to log in after making a connection. If the user fails to enter a valid login name and password within this time, the computer breaks the connection, thus protecting itself against crackers as well as freeing up resources. Definition of time out, timeout or time-out, MICROSOFT PRESS Computer Dictionary.

Second Alternate Rejection - Claim Rejections - 35 USC § 103

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Official Notice. See above.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Dell Uses Internet to Offer Small Business Customers Personalized Sales and Educational Programs, *Business Editors & Technology Writers*. *Business Wire*, New York: Jul 20, 1998, downloaded from ProQuest on the Internet on 14 October 2004, 2 pages.

As per claim 38, Henson ***does not*** specifically disclose that at least one characteristic in the user profile comprises an indicator that indicates the number of times that the user requested automated assistance. Henson discloses PREMIER PAGES, Col. 14, lines 35-61. PREMIER PAGES keep track of a customer's purchase and service history, as evidenced by Dell Uses Internet to Offer Small Business Customers Personalized Sales and Educational Programs, *Business Editors & Technology Writers*. *Business Wire*, New York: Jul 20, 1998, downloaded from ProQuest on the Internet on 14 October 2004, 2 pages.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to disclose storing in a customer database information such as an indicator that indicates the number of times that the user requested automated assistance.

One of ordinary skill in the art at the time the invention was made would have been motivated to disclose storing in a customer database information such as an

indicator that indicates the number of times that the user requested automated assistance for the obvious reason that by storing the information, a merchant can determine whether particular customers need more assistance than others. In addition, tracking service histories of products assists merchants to determine that particular products are less reliable and are responsible for a large number of requests for assistance, for example.

Response to Arguments

Applicant's arguments filed 17 March 2005 have been fully considered but they are not persuasive.

Applicant's arguments, Page 12, line 21-page 13, line 27, appear to be mere recitals of claims 1, 18, and 37 and fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant argues, page 12, lines 9-20 and page 14, lines 10-22, that the Examiner has not made a prima facie case of obviousness. In response to these arguments, the Examiner respectfully notes that Henson discloses PREMIER PAGES, Col. 14, lines 35-61. Dell describes some properties of PREMIER PAGES. It would have been obvious to one of ordinary skill to combine Henson and Dell to find out details of how PREMIER PAGES works. Together, the references disclose applicant's claimed invention. In response to Applicant's comments concerning reasonable

expectation of success, the Examiner respectfully notes that Dell shows a successful use of PREMIER PAGES. Therefore, applicant's arguments concerning lack of a *prima facie* case of obviousness are not persuasive.

Further, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves ***or in the knowledge generally available to one of ordinary skill in the art.*** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Both Henson and Dell provide descriptions concerning on-line methods and systems for optimizing products, user profiles and other features claimed by applicant.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant again relies on selected portions of Henson and Dell to argue

... ***do not*** teach or suggest updating at least one characteristic in a user profile to create an updated user profile and storing the updated user profile to determine the set of content and format of the formatted display for a subsequent presentation made to the user.

... fails to teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to the user.

... only describes a web-based online store having a user interface for enabling a custom configuration of a computer system according to an identification of a user belonging to a prescribed customer set. (See ***Abstract***). The customer is identified as being in a particular customer set according to the link the customer executed to get into the store (See ***Col. 14, lines 4 through 34***).

...**does not** teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to said user...

In response to these arguments, the Examiner again respectfully directs applicant's attention to portions of Henson that disclose that Henson permits customers to select and update characteristics of their profile to create an updated profile and storing the information. Fig. 8, for example, shows that customers may change their type of business or organization, and Henson changes displays, options, merchandising and pricing accordingly. See also at least Col. 10, lines 30-Col. 11, line 9.

Concerning Dell, applicant argues,

Further, Dell fails to teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to the user. Dell only describes a personalized web site that keeps track of a customer's purchase and service history. (**See Page 2**). Dell **does not** teach or suggest storing an updated user profile to determine the set of content and format of the formatted display for a future presentation made to said user.

In response to these arguments, the Examiner respectfully directs applicant's attention to other portions of the same reference, which disclose that Dell stores updated profiles to determine set of content and format of formatted display for future presentations:

[customers]...will receive a more personalized sales experience...using the Internet to offer personalized on-line services designated specifically.....

[Dell] ...customize sales presentations. A representative determines a customer's needs, customizes the information to address the customer's issues....

Dell designs and customizes products and services to end-user requirements, and offers an extensive selection of peripherals and software...Information on Dell and its products can be obtained though its toll free number...and by accessing the Dell World Wide Web Server at www.dell.com...

Thus, both Henson and Dell disclose customizing and personalizing according to updateable user profiles. The Examiner respectfully notes that applicant has not argued or shown that his use of **profile** differs from the normal ordinary meaning of the term.

Applicant comments

It should be noted that the foregoing is not an exhaustive list of claimed features not taught or suggested by the references of record, and that further limitations are believed to be novel and non-obvious over Henson and Dell. Page 14, lines 7-9.

In response to these arguments, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please note that the following references are cited merely to explain the meaning of the term PREMIER PAGES, and to show that characteristics not disclosed in Henson are inherent in PREMIER PAGES as of the filing date of Henson, 22 September 1998. See MPEP 2131.01, Multiple Reference 35 U.S.C 102 rejections.

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8. Administaff Announces Preferred Purchasing Agreement With Dell, PR Newswire. New York: Apr 16, 1998. p. 1, 2 pages, downloaded from ProQuest Direct on the Internet, 1 June 2005.
9. The InternetWeek Interview -- Michael Dell, chairman and CEO, Dell Computer, InternetWeek. Manhasset: Apr 13, 1998. p. PG.8, 3 pages, downloaded from ProQuest Direct on the Internet, 1 June 2005.
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12. Dell's new deal, Dana Blankenhorn. Advertising Age's Business Marketing. Aug 1997. Vol. 82, Iss. 7; p. 27, 1 page, downloaded from ProQuest Direct on the Internet, 1 June 2005.
13. Direct Path to sales success: All childs play for today's computer kids and Dell-may-care. Strait Times, Singapore, May 6, 1997, 2 pages, downloaded from ProQuest Direct on the Internet, 1 June 2005.
14. www.dell.com pages as of 30 January 1998. downloaded from the Internet on 13 February 2003, from www.archive.org, ~~24 pages~~, 19 Pgs

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10 June 2005

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